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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/547,563 04/12/00 SIEGLER

M 68410

022242 PM82/0822
FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO IL 60603-3406

EXAMINER

COHEN, C
ART UNIT PAPER NUMBER

3634
DATE MAILED:

08/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/547,563

Applicant(s)
Siegler et al

Examiner
Curtis Cohen

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3634



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 12, 2000
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Reissue Applications

Claims 5-16 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

The Declaration of the instant application states that it is applicants' intent to broaden the scope of the claims. Specifically, the parent applications (U.S. Serial Numbers 08/829,742, now Patent Number 5,743,046, which is a continuation of Serial Number 08/456,874, abandoned) include claims having the structure of a "means for preventing the garage door from opening." The instant application includes two new independent claims having language that replaces the "means for preventing" with *a portion* of all the elements recited in the specification that are encompassed by the "means for preventing." Broadening the scope of the claims constitutes impermissible recapture for the following reasons.

In the parent applications, claims 1-4 were rejected under Section 102(b) as being anticipated by Ball et al. Arguments were presented in the amendment filed as paper number 7 of Serial Number 08/456,874 that persuaded the examiner that the claims were allowable over the prior art of record (see arguments on page 4-5 of the amendment). In those arguments, structural details of the elements that constitute the means for preventing the garage door from

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opening are set forth. Particularly, on page 5 of the amendment, applicants purport that Ball et al *fails to disclose a means for preventing the garage door from opening* (page 5, lines 3-5) where the structure defining the means was set forth on the previous page of the arguments.

A means plus function clause under Section 112 (6th paragraph) encompasses the structure and function as recited in the specification, along with any equivalence thereof. Since applicant is now reciting the particular structure and function, *which does not include any equivalent structure*, the claim would appear to be narrowed, not broadened. However, this only applies if every single element recited in the specification that is encompassed by the “means for preventing” is included in the independent claims. This is not the case. The independent claims fail to recite every element set forth in the specification that makes up the “means for preventing rotation.”

Allowable Subject Matter

Claims 1-4 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Cohen whose telephone number is (703) 308-2106.

The fax phone number for this Group is (703) 305-7687.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

C. Cohen 

August 21, 2001